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IN THE

Supreme Court of the United States

OCTOBER TERM, 1973

No. 73-313

R. LEE FRASER, *Petitioner,*

vs.

CONTINENTAL REALTY CORP., a corporation; CENTURY BUILDING CORP., a corporation; INTERNATIONAL ENVIRONMENTAL DYNAMICS, INC., a corporation; CANN TERMOHLEN, architects; OAK RIDGE CONSTRUCTION COMPANY, a corporation; and HEEDE INTERNATIONAL, INC., *Respondents.*

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Fourth Circuit

BRIEF FOR RESPONDENTS IN OPPOSITION

ARGUMENT

I. IT IS THE WELL ESTABLISHED POLICY OF THIS COURT TO DENY CERTIORARI IN PATENT CASES EXCEPT UNDER EXCEPTIONAL CIRCUMSTANCES NOT PRESENTED BY THIS CASE.

Rule 19 of this Court declares that "A review on writ of certiorari is not a matter of right, but of sound judicial discretion and will be granted only where there are special and important reasons therefor". As stated by Chief Justice Vinson in his often quoted address before the American Bar Association on September 7, 1949:

> "The Supreme Court is not, and never has been, primarily concerned with the correction of errors in lower court decisions. In almost all cases within the Court's appellate jurisdiction, the petitioner has already received one appellate review of his case . . .
>
> The function of the Supreme Court is, therefore, to resolve conflicts of opinion on federal questions that have arisen among lower courts, to pass upon questions of wide import under the Constitution, laws and treaties of the United States, and to exercise supervisory power over lower federal courts . . .
>
> *To remain effective the Supreme Court must continue to decide only those cases which present questions whose resolution will have immediate importance far beyond the particular facts and parties involved.*" 69 S.Ct. v, vi (emphasis added).

The application of these principles to patent cases has resulted in a consistent policy of this Court of declining to review factual issues concerning the validity and infringement of particular patents in the ab-

sence of a direct Appellate Court conflict over those issues. As stated in *Universal Oil Co. v. Globe Oil Co.*, 322 U.S. 471 (1943):

> "Where the questions presented by the contested claims of infringement and validity are purely factual, this Court ordinarily accepts the concurrent conclusions of the district court and Circuit Court of Appeals in these cases. Goodyear Co. v. Ray-O-Vac., 321 U.S. 275." (Supra at p. 473).

In the present case the decision of the District Court as affirmed by the Fourth Circuit Court of Appeals holds that the petitioner so limited his patent claim during its prosecution in the Patent Office that, *as a matter of law,* he will not now be allowed to expand the scope of that claim to recapture what was previously surrendered in an effort to bring respondents' structure within its reach.

This case presents no compelling issues as to standards of patentability or meaning of invention. *Graham v. John Deere Co.*, 383 U.S. 1 (1966); *United States v. Adams*, 383 U.S. 39 (1966).

This case presents no conflict of decision among the Circuit Courts of Appeals. *Sanitary Refrigerator Co. v. Winters*, 280 U.S. 30 (1929). To the contrary, it is to be noted that the summary judgment granted by the District Court and affirmed by the Fourth Circuit in this case is identical in form to that rendered (and affirmed) against the petitioner in this case on the same patent asserted here by the Courts of the Fifth Circuit in *Fraser v. City of San Antonio, Texas, et al.*, 430 F.2d 1218 (Ct. Appls., 5th Cir., 1970).

This case does not involve a patent of "unusual public importance". *Marconi Wireless Tel. Co. v. United States,* 320 U.S. 1 (1942).

In short, there has been no reason presented by petitioner for this Court to deviate from its well established policy of refusing to hear issues which are narrowly confined to determining the proper scope of a particular patent under well established principles of law.

II. THE DOCTRINE OF FILE WRAPPER ESTOPPEL PRECLUDES THE PETITIONER AS A MATTER OF LAW FROM ASSIGNING A SCOPE AND INTERPRETATION TO HIS PATENT CLAIM WHICH WOULD INCLUDE WITHIN ITS AMBIT RESPONDENTS' STRUCTURE.

A patent claim and the range of structures within the scope of a claim must be construed and measured in light of the patent's history of prosecution before the United States Patent Office. *Graham v. John Deere Co.,* supra. A patent applicant in prosecuting his patent application before the Patent Office can narrow or limit his claims to distinguish his invention from "prior art" structures. When, however, he so narrows or limits his claims in order to distinguish, and thereby avoid, relevant prior art, the construction of the claim obtained by the successful patentee is thereafter limited. The patentee will not be allowed to later assert in Court under the banner of "equivalence" that the claim is broader in scope than the limitation which he deliberately adopted in order to secure his patent grant. *Exhibit Supply Co. v. Ace Patents Corp.,* 315 U.S. 126 (1941). The following language from the Court's opinion in *Graham v. John Deere Co.,* supra, is illustrative:

> "It is, of course, well settled that an invention is construed not only in the light of claims, but also with reference to file wrapper or prosecution history in the Patent Office . . . Claims as allowed must be read and interpreted with reference to rejected ones and to the state of the prior art; and *claims that have been narrowed in order to obtain the issuance of a patent by distinguishing the prior art cannot be sustained to cover that which was previously by limitation eliminated from the patent.*" (Supra at p. 33; emphasis added)

This is precisely the basis on which the District Court and the Circuit Court of Appeals rejected as a matter of law petitioner's claim of patent infringement asserted here.

It is uncontrovertible that the patent claim in issue (claim 1) at lines 14 and 15, calls for "a *central* substantially large, *single cylindrical* core", around which the floors are raised and to which they are attached and placed. It is also uncontrovertible that the accused structure known as the Downtown Holiday Inn in Huntington, West Virginia, includes *two* towers, rectangular in section and spaced apart for supporting each floor. Neither of the towers is "central" with respect to the building's floors.

The claim in issue here (which was claim 2 of the application) was rejected as unpatentable over the method of German Patent No. 833,556, which was considered by the Patent Examiner as showing the active procedural steps of the invention as originally set forth in the claims. The claim was amended by the applicant-petitioner to insert the words "large" and

"single" in the phase "a central substantially *large, single,* cylindrical core". (inserted words in italics).

Argument was made to the Patent Office to support patentability over the cited prior art because of the insertion of the "large, single" limitation. Specifically, the subject claim was represented as distinguished from the structure disclosed in the German patent on the basis that the latter did not disclose a *single core* for housing various parts of the building. Nor did this patent include a method for supporting a plurality of floors from a single core.

Under the doctrine of File Wrapper Estoppel the petitioner may not now recapture in his claims by an interpretation thereof broadened by arguments of equivalency that which he deliberately surrendered by amendment to obtain his patent. *Exhibit Supply Co. v. Ace Patents Corp.,* supra.

Recognizing the applicability of the equitable principle of File Wrapper Estoppel to his asserted claim, petitioner, at page 18 of his Petition, asks this Court in effect to overrule its decisions including *Exhibit Supply Co. v. Ace Patent Corp.,* supra, on the basis that these decisions constitute a denial of the Due Process Clause of the Fifth Amendment.

This argument proceeds from the erroneous assumption that "any patentee who had been compelled to amend his claim must of necessity acquiesce in the judgment of the Patent Office." Petitioner argues further that "to determine to any degree what the rights of the patentee are even before he gets a judicial hearing" is a denial of due process. Petitioner con-

cludes, therefore, that because of their non-judicial character, decisions of the Patent Office "should not be afforded any sort of *res judicata* effect."

It appears that the petitioner's error in logic is based on his unfamiliarity with Patent Office procedure as formulated by Congressional directive. Specifically, Title 35 of the U.S. Code, §134, provides:

> "Appeal to the Board of Appeals. An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the primary Examiner to the Board of Appeals. . . ."

Sections 141[1] and 145[2] of Title 35 provide for alternative *judicial hearings* (one appellate in form and the other a trial de novo) for an applicant dissatisfied with the decision of the Board of Appeals.

The indisputable conclusion to be drawn from these statutory provisions is that petitioner had the right to seek judicial review of the Patent Examiner's action

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[1] 35 U.S.C. 141. *Appeal to Court of Customs and Appeals.*
An applicant dissatisfied with the decision of the Board of Appeals may appeal to the United States Court of Customs and Patent Appeals, thereby waiving his right to proceed under Section 145 of this title . . .

[2] 35 U.S.C. 145. *Civil Action to Obtain Patent.*
An applicant dissatisfied with the decision of the Board of Appeals may unless appeal has been taken to the United States Court of Customs and Patent Appeals, have remedy by civil action against the Commissioner in the United States District Court for the District of Columbia if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints. The court may adjudge that such applicant is entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the Board of Appeals, as the facts in the case may appear and such adjudication shall authorize the Commissioner to issue such patent on compliance with the requirements of law. All the expenses of the proceedings shall be paid by the applicant.

but chose not to exercise that right. Having elected to forego the judicial review available to him he cannot now argue to this Court that he has been denied due process of law.

III. THE DISTRICT COURT'S DISPOSITION OF PETITIONER'S SUIT BY SUMMARY JUDGMENT WAS PROPER SINCE AS A MATTER OF LAW THE PATENT CLAIM IN ISSUE CANNOT BE BROADENED BY INTERPRETATION TO INCLUDE RESPONDENTS' STRUCTURE.

This Court has approved the use of summary judgment to dispose of patent infringement claims. *Milcor Steel Co. v. George A. Fuller Co.,* 316 U.S. 143 (1941); *Morton Salt Co. v. G.S. Suppiger Co.,* 314 U.S. 488 (1941).

In the present case the District Court's use of summary judgment was entirely proper since no expertise is needed to understand the art involved and the meaning of the claim terminology is made so incontrovertibly clear by the patent prosecution history that no genuine issue of fact exists. *Morpul, Inc. v. Glen Raven Knitting Mill, Inc.,* 357 F.2d 732, 149 USPQ 1 (4th Cir. 1966). See also *Welch v. General Motors Corp.,* 330 F.Supp. 80 (D.C., E.D. Va.) affd. per curiam 170 USPQ 1 (4th Cir. 1970); *Smith v. General Foundry Machinery Co.,* 174 F.2d 147, 81 USPQ 297 (4th Cir.), cert. denied, 338 U.S. 869, 83 USPQ 543 (1949); *Inglett & Co. v. Everglades Fertilizer Co.,* 255 F.2d 342, 117 USPQ 236 (5th Cir. 1958); *Frederick Hart & Co. v. Recordgraph Corp.,* 169 F.2d 580, 78 USPQ 310 (3rd Cir. 1948).

The United States Court of Appeals for the Fourth Circuit has clearly enunciated the legal principles which are controlling in the present case in *Morpul, Inc. v. Glen Raven Knitting Mill, Inc.*, supra. The *Morpul* case, like the present one involved an appeal from the granting of a motion for summary judgment in defendant's favor on a finding of lack of infringement due to the application of File Wrapper Estoppel. The Court held that the patentee-plaintiff had so narrowed the scope of his patent claim during its prosecution that "the meaning of the disputed term is made so incontrovertibly clear in the file wrapper history that no genuine issue of fact exists" (supra at 736).

The First Circuit Court of Appeals formulated the test to be applied in determining the propriety of summary judgment in patent cases as follows:

> "Summary judgment under Rule 56(c), Federal Rules of Civil Procedure, 28 U.S.C.A., is sometimes appropriate in a patent case, at least on the issue of infringement. Where it is apparent that there is no genuine issue of fact bearing on infringement, and the structure and mode of operation of the accused device [are] such that they may be readily comprehended by the court, and compared with the invention described and claimed in the patent, without the need of technical explanation by the testimony of expert witnesses, then the court, if satisfied that there is no infringement, should give summary judgment for the defendant, instead of subjecting the parties to the expense of a trial. *Steigleder v. Eberhard Faber Pencil Co.*, 176 F.2d 604, cert. denied, 338 U.S. 893, 70 S.Ct. 244, 94 L.Ed. 548 (1949) (1 Cir. 1949).

See also *Fraser v. City of San Antonio, Texas, et al.*, supra, in which the Fifth Circuit Court of Appeals cited and followed the rule of the *Steigleder* case, supra.

Respondents respectfully submit that the logic and policy of these cases are directly applicable to the present case and should be determinative of this Petition.

CONCLUSION

In view of the foregoing, respondents respectfully submit that the District Court and the Circuit Court of Appeals were correct in determining as a matter of law that petitioner's patent claim does not cover respondents' accused structure. Further, petitioner has failed to show to this Court any reason why it should depart from its well established policy of denying certiorari in patent cases involving the limited issue of whether a particular patent is or is not infringed. Accordingly, respondents respectfully submit that the present Petition should be denied.

Dated, September 17, 1973.

Respectfully submitted,
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